

Remarks/Arguments

In the Advisory Action dated July 29, 2008, the Office indicates that the Request for Reconsideration of the pending application was considered but did not place the application in condition for allowance. The reason the Office provides is that the "applicant's conclusion regarding unexpected results (page 4 of remarks) is unsupported by any factual evidence of record comparing applicant's claimed specific CMC with other conventional CMC, as disclosed in the secondary references." (Advisory Action, page 2). The Office thus maintains the rejection of claims 1-9 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,593,468 to Lange et al. ("Lange") in view of U.S. Patent No. 3,418,133 to Nijhoff et al. ("Nijhoff") and U.S. Patent No. 3,928,252 to Rigler et al. ("Rigler").

Applicants respectfully submit, however, that the Office's basis for maintaining the rejection is misdirected. More specifically, the Office apparently believes Applicants' arguments filed in the Response dated July 16, 2008 were an attempt to rebut the alleged *prima facie* case of obviousness by arguing the invention's unexpected results. Applicants submit, however, that it this is not the case. Rather, Applicants' position is that a *prima facie* case of obviousness has not been made. As a result, the Office's comments regarding the deficiency of Applicants' "conclusion regarding unexpected results" as being unsupported by factual evidence fails to address Applicants' arguments establishing the failure of the Office to establish a *prima facie* case of obviousness in the first place.

Applicants acknowledge that the following statement was included in the July 16, at page 4:

"[u]se of the specific CMC in accordance with the present invention in fruit-based products unexpectedly leads *inter alia* to an improvement in gelling properties, flowing properties, consistency, and stability. Additionally, the use of these gel forming CMCs effectively prevents fluid loss or syneresis and these CMCs are soluble in both hot and cold water. (emphasis in original).

This statement describing the advantages of the claimed invention, however, is no more than a reiteration of the statement made in Applicants' specification, set forth at page 3, lines 6-10. Applicants submit that such a description of the inventions' advantages in no way constituted Applicants' entire argument for patentability. In fact, the July 16 Response includes several grounds for which Applicants contend that the Office's alleged obviousness rejections are flawed and improper and thus fail to establish a *prima facie* case.

It is apparent, based on the Office's comments in the Advisory Action, that the Office has failed to properly consider Applicants' arguments directed to the Office's failure to establish a *prima facie* case of obviousness. Because the Advisory Action instead provides only comments to refute an argument which Applicants did not make, there is no appropriate explanation in the record as to why the rejections are maintained. Without such explanation, how can Applicants be expected to appropriately respond to the Office's pending rejections or prepare an appropriate Appeal to the Board of Patent Appeals and Interferences?

As set forth in the M.P.E.P., "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." M.P.E.P. § 2142; see also, *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. § 2142. It is only when the examiner does produce a *prima facie* case, that it is incumbent on the Applicant to provide evidence, such as unexpected results, to overcome the rejection. See M.P.E.P. § 2142. Here, because the Office has failed to establish a *prima facie* case of obviousness for at least the reasons set forth in the July 16 Response, providing evidence of secondary considerations, such as unexpected results, is premature.

Applicants therefore respectfully request reconsideration of the July 16, 2008 Response, in its entirety. Applicants respectfully submit that in view of all of the arguments presented in the July 16 Response, the present application is believed to be in condition for allowance, which action is respectfully requested. However, if, after fully

reconsidering the Response, the rejections are to be maintained, in the very least
Applicants request an explanation as to why each of the rejections are maintained.

Respectfully submitted,



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